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PLEASE SEE ATTACHED RESPONSE TO OFFICE ACTION IN PATENT
APPLICATION NO. 09/761,573

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Serial No. 09/761,573

Atty. Docket No. 13DV13120

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
David M. Bains et al. : Group Art Unit: 3682
Serial No.: 09/761,573 : Examiner: D. Fenstermacher
Filed: January 18, 2001 : Response to Paper No. 4
For METHOD AND SYSTEM FOR
PERFORMING GEARBOX FINAL
ASSEMBLY CLEAN CHECK

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REPLY UNDER 37 CFR § 1.111

AUG 08 2002

Assistant Commissioner for Patents,
Washington, DC 20231

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S I R:

In response to the Office Action dated May 8, 2002, applicant hereby respectfully requests further examination and reconsideration of the above-identified application in view of the following remarks. Claims 1-30 remain pending in the application.

REMARKS

The Examiner has rejected claim 22 under 35 U.S.C. § 112, second paragraph, as being indefinite. This ground of rejection is respectfully traversed.

(W0045629.1)

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Serial No. 09/761,573

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The Examiner contends that claim 22 states that the filter is a pump. However, applicant respectfully submits that the Examiner has read this portion of the claim out of context. Specifically, one of the elements recited in independent claim 21 is a "means for causing said oil-based fluid to flow through said gearbox and said filter." Claim 22, which depends from claim 21, recites that the *means for causing said oil-based fluid to flow through said gearbox and said filter* is a pump. Claim 22 does not recite that only the filter is a pump. Accordingly, it is submitted that claim 22 is definite within the meaning of 35 U.S.C. § 112, second paragraph, and the Examiner is respectfully requested to withdraw the indefiniteness rejection.

The Examiner has rejected claims 21-30 under 35 U.S.C. § 102(b) as being anticipated by Reinosa. This ground of rejection is respectfully traversed.

As an initial point, it is noted that the Reinosa reference, U. S. Patent No. 5,743,231 issued April 28, 1998, is not listed on the Notice of References Cited, Form PTO-892 that was provided with the Office Action dated May 8, 2002. Applicant respectfully requests that this reference be officially made of record in the present application.

Independent claim 21 recites a system for performing a clean check on a gearbox. The system comprises a source of an oil-based fluid fluidly connected to the gearbox inlet, a filter fluidly connected to the gearbox outlet, and a means for causing the oil-based fluid to flow through the gearbox and the filter.

Reinosa discloses a method and apparatus for preventing wear in an internal combustion engine. As such, Reinosa simply does not teach or suggest a system for performing a clean check on a gearbox as required by claim 21. The apparatus of Reinosa is intended to function during the normal operation of the internal combustion engine and does not provide a clean check

of the component prior to its operation. Furthermore, Reinosa fails to teach or suggest the recited elements of claim 21. The apparatus of Reinosa includes an oil sump 12 that is associated with an internal combustion engine 56 and contains lubricating oil 10. A pump 18 is provided for pumping oil 10 from the sump 12 to a "high arrestance" filter 38. The high arrestance filter 38 provides a substantially higher arrestance rating and chemical removing capability than the conventional oil filter F.

The Examiner asserts that Reinosa shows a gearbox 12 in the form of an internal combustion engine. Applicant respectfully disagrees. Neither the sump 12 nor the internal combustion engine 56 of Reinosa is a gearbox. Although gearboxes are often utilized in connection with internal combustion engines, the engines and the sumps are separate and distinct from the gearboxes. Furthermore, claim 21 requires a source of an oil-based fluid that is fluidly connected to the gearbox inlet. If the sump 12 of Reinosa is the gearbox, as alleged by the Examiner, then Reinosa does not show any other structure that would correspond to the claimed oil-based fluid source.

For the above reasons, it is respectfully submitted that independent claim 21 is allowable over Reinosa. Claims 22-30 depend from claim 21 and are thus also believed to be allowable. Furthermore, at least some of these dependent claims set forth limitations not met by the prior art. For instance, claim 24 recites that the oil-based fluid is MIL-L-23699 oil. The fluid of Reinosa is engine lubricating oil, which is clearly distinct from engine lubricating oil.

In addition, claim 25 recites that the system further includes a means for soaking the filter in a solvent. There is not disclosure in Reinosa of a means for soaking the filter 38 in a solvent. Claim 29 recites a second filter fluidly connected between the oil-based fluid source and the gearbox inlet. While Reinosa does disclose another filter, the conventional oil filter F, this filter is not connected between a source of oil-based fluid and a gearbox inlet.

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Applicant notes with appreciation the indication that claims 1-20 are allowable over the prior art of record.

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration of the objections and rejections is requested. Allowance of claims 1-30 at an early date is solicited.

Respectfully submitted,

8/8/02

Date

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